

Appn No. 09/575,186
Amdt. Dated February 6, 2006
Response to Office Action of December 14, 2005

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REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Specification

Page 1 of the specification has been amended to correct a typographical error. The Applicant submits that this amendment introduces no new matter.

Claim Rejections

The Examiner has rejected claims 1 to 45 under 35 U.S.C 112, second paragraph, as failing to set forth the subject matter which applicant regard as their invention.

On page 2 of the Office Action, the Examiner has stated that "evidence that claim 1 to 45 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the most previous reply filed. In that paper, applicant has stated that the coded data must be interpreted with figure 1 and the attendant passages of the specification that explains figure 1". The Examiner has further stated that "this statement indicates that the invention is different from what is defined in the claim(s) because figure 1 clearly (and as noted by the applicant) has more than the limitations of the claims".

The Applicant respectfully submits that the Applicant has *never* asserted that the term coded data of claim 1 *must* be interpreted with figure 1. In both responses that the Applicant has submitted with respect to the term "coded data", the Applicant has submitted that *an example* of coded data is shown in Figure 1. The Applicant has used Figure 1 in the specification as an example which a person skilled in the art may use if it is required to construe the term "coded data". The applicant has stated that in accordance with MPEP 2173.05(a), the meaning of every term in the claim is apparent from the specification or drawings at the time the application was filed.

Notably, MPEP 2173.05(a) states that "if in the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of invention, and

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Notably, MPEP 2173.05(a) states that "if in the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more".

Additionally, the Applicant refers the Examiner to MPEP 2172 which states that although evidence that shows that a claim does not correspond in scope with that which the applicant regard's as the applicant's invention may be found in contentions or admissions contained in briefs or remarks filed by the applicant, the *content of the applicant's specification cannot be used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as the invention*. Thus, as in the previous responses, the Applicant has referred to various parts of the specification as examples of coded data, the Examiner cannot use these examples provided in the specification as evidence.

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Furthermore, the Applicant respectfully reminds the Examiner that "a fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose... a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought" (see MPEP 2173.01).

Therefore, in view of the above comments, the Applicant respectfully requests that the Examiner withdraws the rejection with respect to claims 1 to 45 under 35 U.S.C 112, second paragraph.

The Examiner has also rejected claims 1 to 45 under 35 U.S.C 103(a) as being unpatentable as noted in the previous Office Action. On pages 2 to 3 of the Office Action, the Examiner has stated that due to the "inclarities in the scope of the intended claims... the claims are interpreted in the broadest reasonable scope and therefore must be rejected as in the previous Office Action". Thus, the Examiner has maintained his rejections with regard to claims 1 to 45 under 35 U.S.C 103(a) as being unpatentable over Cass (US Patent No. 5,692,073).

The Applicant respectfully submits that even with the broadest interpretation of the claims, claim 1 is patentable in view of Cass.

As previously submitted, claim 1 describes a method of enabling the creation and use of a photo album, which the Examiner has asserted is shown in figure 21 of Cass. However, figure 21 of Cass shows a paper copy of a print out of a page 1100, which may include images (see Column 17 line 7). There is no description in Cass of a creation and use of a photo album.

Additionally, claim 1 describes a photo album form containing information relating to a photo album activity and coded data. The coded data is indicative of an identity of the photo album form and at least one reference point of the photo album form.

In contrast, Cass describes a Paper Web, where a user marks a piece of paper with an X (akin to clicking on a hyperlink) and scans the marked paper to a computer. The Paper Web then interprets these marks made by the user and follows the links to retrieve the pages corresponding to the mark made by the user (see Column 17 lines 4 to 16). Cass does not describe the pages having information related to photo album activity and coded data. Even if the Examiner is alleging that the marks made by the user are "coded data", these marks are not indicative of an identity of the page which they mark, or at least one reference point of that page. The Applicant fails to see any description, suggestion, or teaching in Cass of a page having coded data indicative of an identity of the photo album form and at least one reference point of the photo album form.

Furthermore, the current claim 1 describes a computer system receiving indicating data from a sensing device operated by the user. The indicating data includes the identity of the photo album form and a position of the sensing device relative to the photo album form, when the sensing device is placed in an operative position relative to the photo album form. In contrast, Cass describes the Paper Web pages being scanned or faxed to a computer (see Column 17 lines 6 to 7). There is no suggestion or teaching in Cass of the sensing device being able to send indicating data to a computer, where the indicating data includes the identity of the photo album form and a position of the sensing device.

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Consequently, Cass teaches away from the present claim 1, as Cass sends information regarding the marked X to a computer, where the mark X represents the link to the next page that the user wants to view. In contrast, the coded data in the present claim 1 describes the identity of the current page.

The Applicant respectfully highlights section 2143.01 of MPEP which states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.

Thus, the Applicant respectfully submits that a prima facie case of obviousness is not established as Cass describes a system which teaches away from the present claim 1, and the modification of Cass such that the coded data identifies the current page would change the principle of operation of Cass.

Furthermore, in order to establish a prima facie case of obviousness, MPEP 706.02(j) states:

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, as there is no suggestion, or motivation to modify Cass to teach the method as described by claim 1, and as Cass does not teach or suggest all of the claim limitations, the present claim 1 is patentable over Cass.

The Applicant further submits, that as previously highlighted, the dependent claims in the present application present further features which are patentable over the cited prior art. For example, claim 4 of the present application describes movement of the sending device relative to the page and requires that such movement is detected. There is absolutely no disclosure of any such operation in Cass, and thus at least claim 4 is patentable in view of Cass.

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In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,
Applicants:



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